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EXAMINER

PURVIS, SUE A

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1734

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/020,136
Filing Date: December 18, 2001
Appellant(s): COMISKEY ET AL.

MAILED

FEB 06 2006

GROUP 1700

Yisun Song
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 November 2005 appealing from the Office action mailed 21 June 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 22 August 2005 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 21-24 and 31-34 stand rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 4,719,909 to Micchia et al. ("Micchia") in view of US Patent No. 1,300,592 to Essig ("Essig").

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

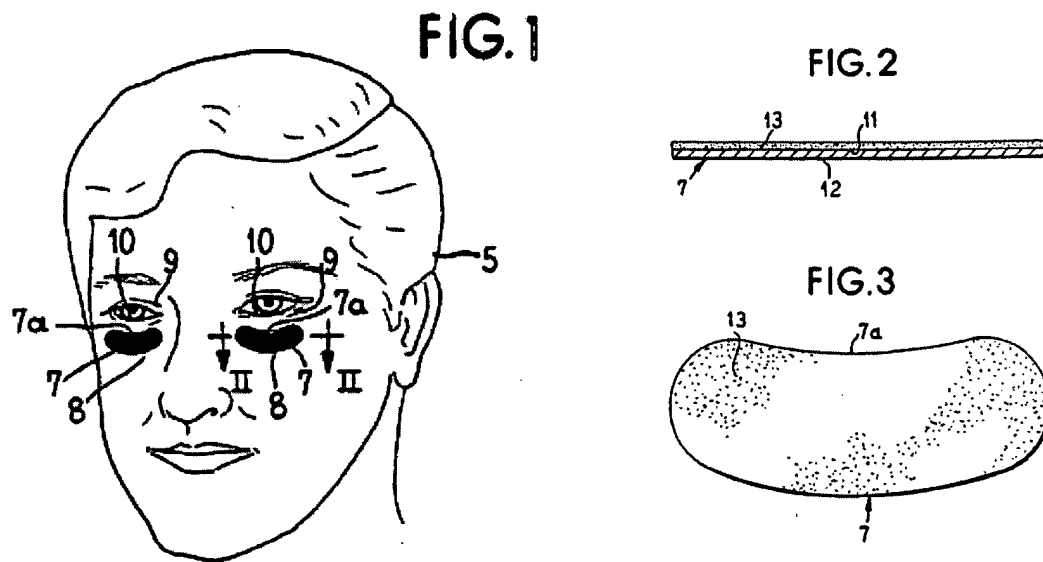
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. (US Patent No. 4,719,909) in view of Essig (US Patent No. 1,300,592).

Regarding applicant claims 21 and 31, Micchia et al. disclose a method of reducing light glare into a human's eyes from the human's cheeks comprising the steps of:

(1) Providing a decal (patch) 7 comprising a shaped (kidney) body portion 11 having a light-absorbing, hypoallergenic (non-toxic), exterior black surface 12 (which would have a wavelength falling outside the range of 430 and 690nm) and also comprising an adhesive on the opposite surface 13 (Figures 1-3; column 2, lines 22-41; column 2, lines 49-50).

(2) Placing the decal 7 underneath the human's eyes on the cheek area defined by the zygomatic arch whereby incident light rays directed to the zygomatic arch area is substantially absorbed and reflection into the eyes is avoided (column 2, lines 14-21). The method of Micchia et al. is illustrated below:



Although Micchia et al. disclose the overall method and decal structure, they do not specifically disclose, as set forth in applicant claims 21 and 31, that the decal also comprises a shape formed within the exterior surface which has a color contrasting to the non-reflective color and is configured to provide communication.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the decal of Micchia et al. with a shape formed within the exterior surface which has a color contrasting to the non-reflective color in order to provide communication, motivated by the fact that Essig, also drawn to method for the formation and application of adhesively backed removable decals onto the human body, discloses that where a part of the decal (patch) 4 is to be exposed, it is desirable to impart a particular hue or color the exposed (outer or exterior) part of the decal (page 1, column 1, line 45 to page 1, column 2, line 68) such that the whole surface or only parts of the surface have surface ornamenting material applied thereto (page 1, column 2, lines 87-92). Essig further discloses that the ornamenting materials include inks, dyes, flock, tinsel (glitter) and the like (page 1, column 2, lines 68-71; page 1, column 2, lines 101-109). The method of Essig is illustrated below:

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As illustrated above, the decal of Essig communicates to the viewer an image of a butterfly.

Although Micchia et al. do not specifically disclose, as per applicant claims 21 and 31, that the decal is removed within a week after application, it would have been obvious to one of ordinary skill in the art at the time of invention that the decal of Micchia et al. would have been removed within this time period motivated by the fact that they disclose that the major utility of the decal 7 is in connection with athletic activity such as football, baseball, basketball, tennis, golf and the like (column 3, lines 17-19) and furthermore by the fact that it is a well-understood general concept that such athletic activities generally span time periods of several hours to one day, but most definitely less than one week.

Regarding applicant claims 22 and 32, Micchia et al. disclose that the decal 7 utilizes a top face 12 comprising a non-reflective portion and a bottom face of pressure sensitive adhesive (PSA) 13 which facilitates the attachment of the decal 7 to the zygomatic cheek

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portion of the user when applied and pressed thereon (column 2, lines 22-26; column 3, lines 30-34).

Regarding applicant claims 23 and 33, Micchia et al. disclose that the exterior surface 12 of the decal 7 is colored/dyed black which would have a wavelength falling outside the range of 430 and 690nm (column 2, lines 37-41).

Regarding applicant claims 24 and 34, While Micchia et al. disclose that the decal 7 is suitable for use by a participant in an athletic contest (such as in football, baseball, basketball, tennis, golf and the like) and is applied immediately or near the beginning of the start of the contest (such as in the locker room or at the playing field – column 3, lines 3-7), they do not specifically disclose that the decal is removed within a “few” hours or less after the athletic contest or event is over. Nonetheless, the skilled artisan would have been appreciative of the fact that the decal 7 of Micchia et al. would be removed within a short period of time after the conclusion of the athletic contest or event motivated by the fact that it is well-known and generally accepted that equipment specifically designed for use during an athletic event (cleats, pads, etc.) is removed shortly after the conclusion of the event.

Claims 26-30 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. in view of Essig as applied to claims 21 and 31 above, and further in view of Ross et al. (US Patent No. 5,470,351).

Micchia et al. and Essig, as combined above, disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in

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the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 26-30 and 36-40, that the shape of the interior design and/or outer shape of the decal provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the decal resulting from the combination of the Micchia et al. and Essig references to provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities, as set forth in applicant claims 26-30 and 36-40, motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the decal can be formed in such a way as to provide a precise shape forming a pattern, words or logo (column 2, lines 50-53). Furthermore, the specifics of the claimed pattern would have been the result of obvious design choice by the skilled artisan.

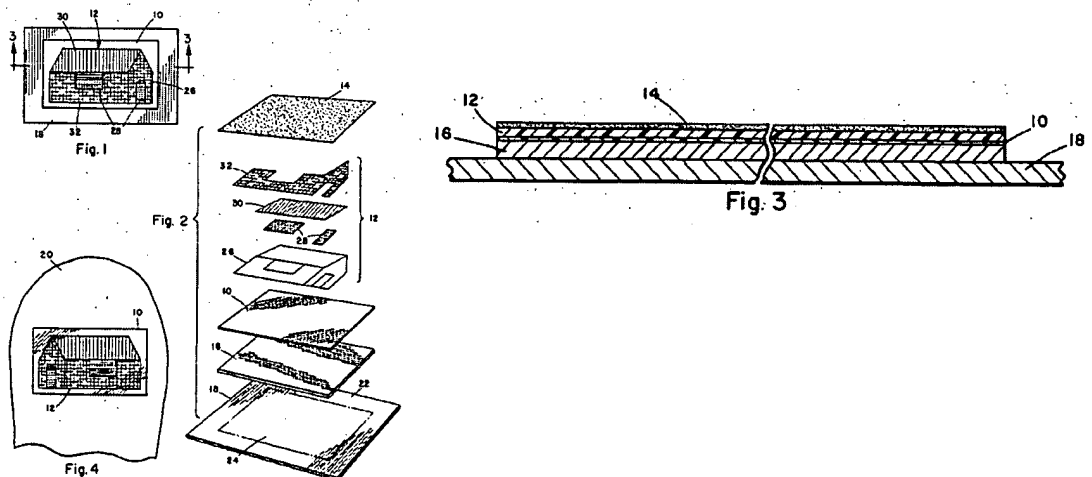
Claims 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al. in view of Essig as applied to claims 21 and 31 above, and further in view of Humason et al. (US Patent No. 4,522,864).

Micchia et al. and Essig, as combined above, disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 25 and 35, that the decal is provided in the

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form of a tattoo and applied via transfer from a carrier substrate under the application of moisture and pressure.

Humason et al., however, also drawn to methods for the formation of decals for application to the human body via transfer, i.e., tattoos, disclose a process comprising the steps of: (1) Providing a carrier substrate (decals paper) 18 having a plurality of decorative layers 12 disposed thereon wherein the decorative layers 12 define an exterior shape with contrasting colored shape or shapes within the outer boundaries of the decal in such a manner as to provide a communication - the decal tattoo of Humason et al. communicates to the viewer an image of a house (column 2, line 66 to column 3, line 42); (2) Providing a clean skin surface 20; (3) Pressing the side of the carrier substrate 18 having the plurality of decorative layers 12 against the surface of the skin 12; (4) Wetting the exposed surface of the carrier substrate 18 with water during the pressing to ensure adhesion of the decorative layers 12 to the skin; and (5) Peeling the carrier substrate 18 from the decorative layers 18 adhered to the skin surface (column 3, lines 43-55). The method of Humason et al. is illustrated below:



It would have therefore been obvious to one of ordinary skill in the art at the time of invention to apply the decal resulting from the combination of the Micchia et al. and Essig

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references in the form of a transferable tattoo, as suggested by Humason et al., motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the application of the decal by transfer from a carrier substrate is often preferable because the use of a carrier substrate avoids the crumpling or folding of the decal which could occur if application of the decal is attempted by removing it directly from its backing without use of a transfer sheet (column 3, lines 34-47; column 4, lines 5-16).

(10) Response to Argument

On page 7 of the Appeal Brief, applicant contends that Essig does not include "a shape formed within the exterior surface" and "a color contrasting to the non-reflective color" where the shape "is configured to provide communication." In particular on page 8 of the response, applicant takes issue with the identification of the ornamenting material (14) in Essig as meeting this claim limitation. Applicant disregards that it is the combination of references Micchia in view of Essig which is at issue here and that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Micchia teaches the use of an under eye light absorber, but fails to show a color contrast within the exterior surface with a shape. Essig, not only teaches the idea of having an ornamental shaped patch (4) to be placed on the body, but also teaches including ornamental material (14) within the outer shape to further decorate the applied patch (4). When combining these teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was

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shape to further decorate the applied patch (4). When combining these teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the absorber in Micchia can be accented or decorated in the same way as Essig, by providing a contrast within the outer lying shape.

As further discussed at the bottom of page 8, the issue really turns on what the term "communication" means within the claim. Claim states "the shape...is configured to provide communication." There is no clear definition of "communication" in the specification. Applicant does give examples such as "advertisement for a sports apparel or equipment manufacturer or distributor, or a team name, mascot or logo." (See Page 2, lines 20-22 of the Specification or [0004] of US Patent Application Publication No. US 2002/0040757 A1.) However, these examples are listed in dependent claims, thus cannot be relied on as a definition in the independent claim. Thus, the examiner looked to a dictionary definition, which states "the exchange of thoughts, messages, or information, as by speech, signals, writing, or behavior." (See <http://dictionary.reference.com/search?q=communication>.) In particular, the communication claimed is a form of "visual communication," because, as described in the specification (page 2, line 25 or [0005] of US Patent Application Publication No. US 2002/0040757 A1.), the invention is used to communicate to "others" who will be communicated with, those looking at the decal. Visual communication is the communication of ideas through the visual display of information. Primarily associated with two dimensional images, it includes: alphanumerics, art, signs, and electronic resources. (See http://en.wikipedia.org/wiki/Visual_communication.)

Applicant contends at the bottom of page 8, that the image of the butterfly disclosed in Essig is not a form of communication, because it is purely decorative. The examiner disagrees with that position, because a purely decorate item can communicate to the person looking at it. What the item communicates depends upon who is looking at it. For instance,

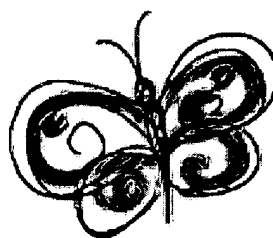
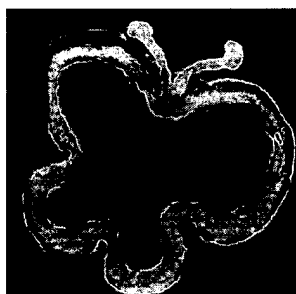
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the following shapes: a heart, eagle, and dove are purely decorative, but they also communicate something to the person viewing them.



Depending on who is looking at it, a heart could communicate a number of different things, such as love, Valentine's Day, or may even make someone think of the human heart. People view the eagle as a symbol of freedom, because the Bald Eagle is the national bird of the United States. A dove is associated with peace and sometimes religion, depending on the viewer. The same can be said about the image of a butterfly. It is the person who views the image who decides what it communicates, and even if the viewer decides that the butterfly is pretty and decorative, that is still a form of communication.

Applicant goes on to argue in the paragraph spanning pages 8 and 9 that the interior markings (14) on the butterfly also fail to provide "communication" because they are mere circles and thus fail to provide communication. Again, the examiner disagrees with applicant's characterization. A mere circle within the butterfly of Essig, gives the outlining shape more distinction and definition, similar to what the markings above give to the eagle. For example, the two drawings below show a butterfly outline and also a butterfly which includes internal markings which gives the butterfly more definition.



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The markings are decorative, but also can provide communication. For example, searching “butterfly logo” or “butterfly symbol” on Google Image demonstrates just how markings contained within a butterfly outline can change to meaning of the butterfly and what it represents. Furthermore, a circle, like a heart, can represent a number of things, depending on who is looking at it and where it is positioned.

Despite applicant’s assertions at the bottom of page 9, the examiner maintains that a *prima facie* case of obviousness has been established. To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant asserts that the third criteria has not been met, but this is simply not the case and has been addressed above.

On page 10 of the Appeal Brief, applicant asserts that the examiner has failed to address the following portion of claim 31: “a shape or shapes bounded by an exterior boundary or boundaries, or an interior boundary or boundaries, or both, wherein the exterior boundary or boundaries, or the interior boundary or boundaries, or both, is or are configured to provide communication.” Applicant then reiterates the arguments they presented with respect to claim 21 on pages 10-13 of the appeal brief. The rejection of claim 31 stands for substantially the same reasons as set forth above. It would have been obvious to one having ordinary skill in the art at the time the invention was made, based on the teachings of Essig, to include interior markings in the article of Micchia, because it is

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desirable to impart a particular hue or color the exposed (outer or exterior) part of the decal as discussed above. Furthermore, the more detailing of the article is within the purview of the artisan based on the teachings of Essig.

On page 13, applicant asserts that the combination of Micchia and Essig is based purely on improper hindsight. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument in the paragraph spanning pages 13 and 14 where applicant argues that Essig contains perfume and thus there would be no motivation to combine it with Micchia, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, one of ordinary skill would not consider adding the "perfume" feature of Essig into Micchia. The examiner has repeatedly denied that assertion. Essig was not relied on for the perfume feature. Applicant is ignoring the other teaching in Essig which is as a beauty mark or beauty spot. Essig teaches use of a decal which has shape and includes decorative or communicative features on that shape. This teaching is combinable with the teaching of Micchia where the decal is placed under the eye and thus worn on the face, within view of an observer.

Despite applicants assertions in the paragraph spanning page 14 and 15, "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). It is the examiner's position that an artisan considering the decal of Micchia, which is used on the face in full view, would be motivated to look at other decals which are used on the body or face in full view for changes or modifications to the decal. Furthermore, it should be noted that in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004) the court rejected the notion that "an express written motivation to combine must appear in prior art references...." (See MPEP 2143.01.) Here, both Micchia and Essig are drawn to the same problem of providing decal which is used on the body.

On page 15 of the Appeal Brief, applicant asserts the motivation of used to combine Essig with Micchia has nothing to do with the deficiencies of Micchia identified. The examiner disagrees, because, by providing the Micchia decal with ornamental or communicative features, as is done in Essig, the perceived problem is overcome.

On page 16, applicant asserts that the suggestion or motivation to combine must be found somewhere in the prior art, however, "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Here, motivation from Essig

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is relied on, because Essig teaches the desire for a decal which includes decorative or communicative, and there is also a certain knowledge of one ordinary skill in the art who would appreciate the need to look to other body decals to modify the decal of Micchia.

Regarding applicant's arguments with respect to claims 22-30 and 32-40 on pages 17-24 of the appeal brief, applicant fails to separately argue these claims, rather applicant just relies on their argument with respect to claims 21 and 31.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sue A. Purvis



Conferees:

Chris Fiorilla



Pat Ryan

